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EXAMINER

STANLEY, JANE L

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/599,946	Applicant(s) HABASSI ET AL.	
	Examiner JANE L. STANLEY	Art Unit 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 June 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 26-62 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 26-62 is/are rejected.
- 7) ☒ Claim(s) 27-29, 35, 46, and 51 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Applicant's reply filed June 9, 2008 has been fully considered. **Claims 1-25** have been cancelled; **claims 26-62** are new and are pending.

Claim Objections

Claims 27-29 are objected to because of the following informalities: the claims recite "of at least one lactone" and should instead recite "of the at least one lactone". Appropriate correction is required.

Claim 35 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. The claim recites component C is "a substituted or unsubstituted benzyl alcohol". However **claim 30**, from which **claim 35** depends, recites the structure of a benzyl alcohol substituted with $(R')_n$ where n is from 0 to 5, hence a substituted or unsubstituted benzyl alcohol.

Claim 46 is objected to because of the following informalities: "esters" appears to be a misspelling of "ester". Appropriate correction is required.

Regarding claim 51, Applicant is advised that should **claim 49** be found allowable, **claim 51** will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it

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is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 34, 41 and 60 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 34, the claim recites “2 to 10% by weight of at least one benzyl alcohol of component C” however **claim 30** from which the claim depends recites “a component”.

Regarding claim 41, in the copy of the claims as received, **claim 41** appears to have a line drawn across the text and it is unclear if the Applicant was intending to cancel/delete this claim, in which case **claims 42-62** are misnumbered.

Claim 60 recites the limitation "optical lens". There is insufficient antecedent basis for this limitation in the claim. Furthermore, it is unclear if **claim 60** was intended to be depending from **claim 59**. For the purpose of this office action, the claim has been interpreted to depend from **claim 59**.

Claim Rejections - 35 USC § 102

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim 62 is rejected under 35 U.S.C. 102(b) as being anticipated by Matsumoto (JP 04068095 A and associated English language Derwent abstract).

Matsumoto teaches a two-component flux cleaner composition that contains component A i.e. a nonionic surfactant, and component B i.e. γ -butyrolactone (Derwent abstract). Matsumoto further teaches the nonionic surfactant to be a polyoxyethylene nonyl phenyl ether (Derwent abstract). Matsumoto further teaches an example (see table, pg 613, example 3 of JP 04068095A) comprising 90 wt% of γ -butyrolactone and a total 10 wt% of nonionic surfactants, where 5 wt% is a polyoxyethylene lauryl ether with 10 EO and 5 wt% is a polyoxyethylene nonyl phenyl ether with 18 EO.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 26-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Machac et al. (US No. 6,608,012) in view of Joye et al. (US No. 5,916,860).

Regarding claim 26-29, 37-47, Machac et al. teaches a cleaning solution comprising 0.1 to 90% by weight of mono esters or cyclic esters i.e. butyrolactone (component A) (col 2 ln 50-51 and 60-61, 65-67) and 0.1 to 10% by weight of non-ionic surfactants i.e. ethoxylated or propoxylated alkyl phenols (component B) (col 4 ln 30, 33

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and 40-41). (this overlaps with the instant claimed ranges of more than 50% by weight, at least 60% by weight, at least 70% by weight, and at least 80% by weight lactone; and 1 to 10% by weight of surfactant)

Machac et al. does not specifically teach the degree of ethoxylation/propoxylation or the number of carbons in the alkyl chain. Joye et al. teaches a cleaning solution comprising γ -butyrolactone (col 4 ln 11-15) and 0.1 to 10% by weight of an ethoxylated or propoxylated alkylphenol non-ionic surfactant (col 2 ln 54-59) with 1 or 2 linear or branched alkyl groups of 4 to 12 carbons (col 3 ln 41-44) and the number of OE and/or OP units between 2 and 50 (col 3 ln 10-11) i.e. nonylphenol ethoxylated with 9 OE units (col 3 ln 61). Joye et al. and Machac et al. are analogous art because they are concerned with the same field of endeavor, namely cleaning solutions comprising lactones and ethoxylated or propoxylated alkyl phenol non-ionic surfactants. At the time of the invention a person having ordinary skill in the art would have found it obvious to use the ethoxylated alkyl phenol non-ionic surfactant of Joye et al. in the composition of Machac et al. and would have been motivated to do so to use a surfactant that renders the composition miscible (Machac et al. col 4 ln 39), facilitates rinsing with water on the substrate to be cleaned, accelerates the cleaning action (Joye et al. col 2 ln 60-63), and has the right amount of alkoxylation to obtain the desired HLB value (Joye et al. col 3 ln 6-9).

Joye et al does not directly teach that the surfactant has an HLB value of from 8 to 15, however Joye does teach as the non-ionic surfactant nonylphenol with 9EO which is a compound of instant formula I wherein $(R_1)_n$ is a nonyl alkyl group, wherein X is an

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-O- link and Y is $(RO)_jH$ with R = ethyl and j = 9. Furthermore, as Joye et al. teaches the ethoxylated or propoxylated alkylphenol with 1 or 2 linear or branched alkyl groups of 4 to 12 carbons, especially nonyl (col 3 ln 41-44), and a number of OE and/or OP of 2 to 50 (col 3 ln 10-11), it is implicit that the nonionic surfactants of Joye et al., especially nonylphenol with 9OE units (col 3 ln 61), would have this property. (the surfactant of Joye et al. overlaps the following ranges: R_1 from 5 to 15, from 7 to 15 carbons; n" equal to one; j from 2 to 20, 4 to 15 and 6-12; R having 2 carbons; R'_1 having C_5-C_{10} alkyl moiety; j' from 5 to 10; and figure NP9)

Regarding claim 30-36, Machac et al. in view of Joye et al. makes obvious the cleaning solution as set forth above. Machac et al. further teaches from 0 to about 90 percent of an alcohol i.e. benzyl alcohol (Component C).

Claims 48-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Machac et al. (US No. 6,608,012) in view of Joye et al. (US No. 5,916,860) and further in view of Nakayama (US No. 6,423,150).

Regarding claims 48-51, Machac et al. in view of Joye et al. makes obvious the cleaning solution as set forth in **claim 26** above.

Machac et al. does not teach the additional compound (Component D) of instant formula II. However, Nakayama teaches a resin cleaning solution comprising cyclic esters i.e. lactones (col 3 ln 40-42) and organic solvents i.e. cumene (instant formula II where R_2 and R_3 are Methyl groups and R_4 is Hydrogen) (col 4 67). Furthermore

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Nakayama teaches the solvent may be 60% by weight or less (col 4 ln 58). Nakayama and Machac et al. are analogous art because they are concerned with the same field of endeavor, namely cleaning solutions comprising lactones and organic solvents. At the time of the invention a person having ordinary skill in the art would have found it obvious to use the organic solvent of Nakayama in the composition of Machac et al. and would have been motivated to do so to promote penetration of the cleaning solution into resin solid matter and to dissolve the resin (col 4 lns 52-54 and 59-60).

Claims 26 and 52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wilkins et al. (US No. 5,215,675) in view of Suwala (US No. 4,812,255).

Wilkins et al. teaches an aqueous stripping solution comprising between about 25 and about 95 parts by weight of butyrolactone (col 2 ln 7-9), and between about 0.01 and about 10 weight % of surfactant, ethoxylated or propoxylated alkyl phenols (col 2 ln 54-55 and 66-68), and a pH from 3 to 4.5 (col 4 ln 11). (this overlaps with the instant claimed ranges of more than 50% by weight; and 1 to 10% by weight of surfactant; and pH from 4 to 7)

Wilkins et al. does not specifically teach the non-ionic surfactant to have an HLB value from 8 to 15. Suwala teaches a stripping solution comprising five member ring lactones (col 2 ln 52) i.e. gamma-butyrolactone (col 3 ln 13), and polyethylene oxide condensates of alkylphenols i.e. nonyl phenol with from 5 to about 25 moles of ethylene oxide per mole alkylphenol (col 3 ln 41-50). Suwala further teaches examples wherein the non-ionic surfactant used is an IGEPAL® brand surfactant i.e. IGEPAL® CO-710

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(see tables 1, 3 and 5; also col 4 ln 18). Suwala and Wilkins et al. are analogous art because both are concerned with the same field of endeavor, namely stripping solutions comprising lactones and ethoxylated alkylphenol non-ionic surfactants. At the time of the invention a person having ordinary skill in the art would have found it obvious to use the specific non-ionic surfactants of Suwala in the composition of Wilkins et al. and would have been motivated to do so in order to use a biodegradable (Suwala, col 3 ln 40) surfactant capable of maintaining any nonwater soluble components in the form of an emulsion during flushing from the surface (Suwala col 3 ln 33-36) and to assist in removing and dislodging loosened coating particles (Wilkins et al. col 2 ln 60-61).

Claims 53-55, 57-58 and 61 are rejected under 35 U.S.C. 103(a) as being unpatentable over Machac et al. (US No. 6,608,012) in view of Joye et al. (US No. 5,916,860).

Machac et al. and Joye et al. make obvious the cleaning solution as set forth in **claim 26** above.

Machac et al. further teaches a method for removing coatings such as paint (organic material soil) (col 1 ln 31-32) by dipping the composition onto the surface (col 1 ln 41; col 5 ln 20-23) under heated conditions i.e. about 45 °C to about 75 °C (col 1 ln 42; col 5 ln 16-17), with an application time between one minute and one hour (col 5 ln 36-38). Machac et al. further teaches the coatings can be removed from automotive body panels and bumpers (col 1 ln 18-19) (a progressive geometry surface).

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Machac et al. does not teach the item to be made of mineral glass. However, Joye et al. teaches a method for cleaning and/or stripping plastic resins from glass supports (col 5 lns 11) i.e. glass disks soiled with cross-linked plastic resins (col 5 ln 12), by immersing the object to be cleaned into the formulation with a contact temperature of from 5 °C to 50 °C for from 1 to 60 min (col 4 ln 26-32). Joye et al. further teaches the objects/surfaces to be cleaned include plastic materials and inorganic glasses (col 4 ln 24-25). Joye et al. and Machac et al. are analogous art because they are concerned with the same field of endeavor, namely methods of removing coatings from surfaces with dipping and heating. At the time of the invention a person having ordinary skill in the art would have found it obvious to include the method of Joye et al. in the method of Machac et al. and would have been motivated to do so to clean oils and greases and to strip paint and plastic resins from many different substrate types (Joye et al. col 4 ln 19-25).

Claims 56 and 59-60 are rejected under 35 U.S.C. 103(a) as being unpatentable over Machac et al. (US No. 6,608,012) in view of Joye et al. (US No. 5,916,860) as applied to **claim 26** above, and further in view of Stewart et al. (US No. 6,432,544).

Machac et al. and Joye et al. make obvious the cleaning solution as set forth in **claim 26** above.

Machac et al. does not teach the method wherein the item is a mold for optical lenses or an ophthalmic lens nor does Machac et al. teach the method further comprising the step of treating the surface with a basic aqueous solution.

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Stewart et al. teaches cleaning ophthalmic lens (col 18 ln 2-4) blanks with a detergent followed by immersion of the blanks into an aqueous potassium hydroxide solution having a normality of about 2.4 and at a temperature 50 °C (col 26 ln 18-23). Stewart et al. further teaches that it is typical to treat the surface of the substrate prior to coating. Stewart et al. and Machac et al. are analogous art because they are concerned with the same field of endeavor, namely substrate stripping/cleaning. At the time of the invention a person having ordinary skill in the art would have found it obvious to use the method of Stewart et al. in the method of Machac et al. and would have been motivated to do so to clean the surface and promote adhesion of subsequently applied coating (Stewart et al. col 16 ln 14-17).

Response to Arguments

The objection to the specification has been withdrawn based on the new abstract submitted by Applicant.

Applicant's arguments, filed on June 9 2008, with respect to **claims 1-4, 26 and 62** have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

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§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JANE L. STANLEY whose telephone number is (571)270-3870. The examiner can normally be reached on Monday-Thursday, 7:30 am - 5 pm, alternating Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Eashoo can be reached on (571) 272-1197. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Mark Eashoo/
Supervisory Patent Examiner, Art Unit 1796

/JLS/